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|--|-------------|----------------------|---------------------------------|------------------|
| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.             | CONFIRMATION NO. |
| 10/653,523   | 09/02/2003  | Paolo Tiramani       | 286357-00004-1                  | 3343             |
| 7590 01/04/2007<br>David C. Jenkins<br>Eckert Seamans Cherin & Mellot, LLC<br>44th Floor<br>600 Grant Street<br>Pittsburgh, PA 15219 |             |                      | EXAMINER<br>CHAPMAN, JEANETTE E |                  |
|  |             |                      | ART UNIT                        | PAPER NUMBER     |
|  |             |                      | 3635                            |                  |
| SHORTENED STATUTORY PERIOD OF RESPONSE   |             | MAIL DATE            | DELIVERY MODE                   |                  |
| 3 MONTHS   |             | 01/04/2007           | PAPER                           |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/653,523

Applicant(s)

TIRAMANI, PAOLO

Examiner

Chapman E. Jeanette

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 17-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Beighton (6959515) (PCT Publication date 11/30/2000). BEIGHTON discloses prefabricated house comprising:

1. two or more modules, each module having
2. a frame 4/3, see column 4, lines 25-57
3. each module having one or more multi-frame openings; see figures 7 and 14
4. the modules structured to be joined at one or more multi-framed openings; see figures 7 and 14 and the accompanying text
5. the multi frame openings are enclosed within a covering 18 over the frame
6. the multi frame openings are structured to be converted into openings; see the abstract
7. the multi frame openings include a pair of spaced apart studs; see

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figures 7 and 14; The Random House College discloses that a stud is "...any of a number of slender, upright members of wood, steel, etc. forming the frame of a wall or partition and covered with plasterwork."

8. a plurality of cross members extending between two studs

Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Beighton in view of Derman (2070924). Beighton lacks the cross members removably coupled to the studs. Derman discloses a cuboid volume with cross members 35/27 and studs 22/19. The studs are removably coupled to the cross members. It would have been obvious to one of ordinary skill in the art to removably couple the studs to the cross members to allow for a greater degree in variation of size of the room modules as shown by Derman.

Claims 7-13, 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beighton in view of Prigmore et al (4779514).

Prigmore et al includes a prefabricated unit with foldable panels. One of the modules is a core having a fixed spaced portion 16/18 and a passive space portion 12/14. The fixed spaced portion having non-foldable walls and the passive space portion having foldable panels. See figure 7 of Prigmore et al. the foldable panels are movable from a first closed position to a second open position. The size of the fixed space in comparison to the passive space has been considered a matter of choice. One of ordinary skill in the art would have appreciated making the modules of any dimensions permitting the intended use, function and purpose of the prefabricated unit. It would have been obvious to one of ordinary skill in the art to modify Beighton to include

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foldable panels and the fixed and passive spaces to permit transport of the prefabricated unit as shown by Prigmore et al.

Regarding claim 9: Beighton discloses the multi-frame opening are structured to be converted into an openings such as windows and doors. See first rejection above.

Regarding claim 10: Beighton discloses modules joined at multi-frame openings with the modules disposed in more that one configuration relative to each other. See figure 7.

Regarding claim 11: Beighton discloses the multi frame opening s enclosed within a covering 18 over the frame and the multi frame openings are structured to be converted into openings. See figure 14

Regarding claim 12-13: see first rejection above

Regarding claim 16: each module includes substantially finished trim. See column 7. It would have been obvious to one of ordinary skill in the art to add any type of trim to provide a finished and completed appearance to the building structure

Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beighton in view of Prigmore et al as applied to claim 13 and 12 and further in view of Derman (2070924). Derman is considered in the same manner as described above.

### ***Response to Arguments***

Applicant's arguments filed 10/10/06 have been fully considered but they are not persuasive.

The affidavit of Robert Delorenzo and exhibits A, B, C filed on 10/10/06 under 37 CFR 1.131 has been considered but is ineffective to overcome the Beighton reference.

Independent claim 1 does not recite a stud; hence it is assumed that the affidavit does not apply to this independent claims. Further the Random House College dictionary, Revised edition, defines stud as "...any of a number of slender, upright members of wood, steel, etc. forming the frame of a wall or partition and covered with plasterwork." As applicant has noted in his affidavit studs and post may both be considered as load bearing though post is less in its load bearing capability. The claims do not recite a certain standard of operation or function that excludes post and includes studs. The Affidavit does not provide a link between what is argued and what is recited in the claims. Further Beighton discloses a frame which may include both studs and post. One can be sure that Beighton discloses an invention that functions at least at a standard level of operation and function. Further, applicant has considered the disclosure of Beighton as non-enabling for the recited invention. Every limitation has been disclosed. It is reasonable to assume that the invention of Beighton functions reasonably. The argument and affidavit reciting the differences between post and studs, does not overcome the fact that Beighton discloses every claimed limitations. The affidavits have not shown or stated or proven that the Beighton reference is not function properly or as they should function.. Further nothing specific or distinguishing has been recited in relation to the studs. Beighton

merely recites a frame; again, a frame may include a stud or a post. Some of the frame members of Beigthon are close together while others are spread apart.

Further, a cross member may be defined as any member forming a bridge or crossing between two other members. No specific limitations have been recited with regards to the cross members.

Further, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that the Derman reference is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, this reference teaches a frame with openings; the frame includes cross members and studs/post. The cross members are removably coupled to the studs; see figure 1. See rejection above. Collapsible frame and detachable frame structures are known in the art and not limited to one type of structure such as that shown by Derman.

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In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Beighton and Prigmore discloses portable building structures. Contrary to applicant's allegations the prigmore reference does disclose the elements recited by the claims. Prigmore further discloses a means to transport the modules to the building site in an efficient time saving, space saving and time cost manner by collapsing some of the modules while not collapsing others.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



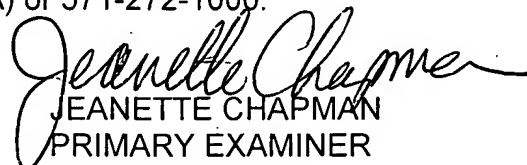
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chapman E. Jeanette whose telephone number is 571-272-6841. The examiner can normally be reached on Mon.-thursday, 8:30-6:00, every fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NAKO SLACK can be reached on 571-272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
JEANETTE CHAPMAN  
PRIMARY EXAMINER  
ART UNIT 3635

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